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REMARKS

1. Applicant thanks the Examiner for the Examiner's comments, which have greatly assisted Applicant in responding.

2. **Claim Rejections – 35 USC § 103**

(a) Claims 1, 2, 4-5, 8-9, 10, 12-13, 16-17, 34-38, 40-47, 49, 52, 57-61, 63-70, 72, and 75 stand rejected under 35 USC 103(a) as being unpatentable by Courts *et al* (Courts), in view of Harrison et al (Harrison).

Applicant respectfully traverses. Applicant incorporates herein remarks from previous responses, namely, descriptions of the claimed invention and of the cited prior art references. In view of the explanations provided previously, Applicant has amended the independent Claims to further clarify the invention. In addition to support cited in previous responses, further support can be found at least as follows (emphasis added):

On page 12, line 15 through page 13, line 7:

- Decision system. In the preferred embodiment of the invention, the decisioning related software, the decision system, is **resident at a data center** and is accessible over the Internet. The software allows business users working with project designer applications to design, test, and deploy decision systems accessible over the Internet and used for automating decisions within the business applications of business users. An exemplary decision system is disclosed and described below in the section, An Exemplary Decision System. For an example of an embodiment of the decision system according to the invention and in an automobile underwriting system, refer to U. S. patent application, Insurance Decisioning Method and System, 09/757,730 (Jan. 9, 2001). For an example of another embodiment of the decision system according to the invention, refer to U. S. patent application, Electronic Customer Interaction System, 09/496,402 (Feb. 2, 2000). The disclosed decision engine is comprised

of strategy trees, business rules, analytic models and user defined functions, sometimes referenced in this document simply as the rules, for making decisions. Project designers, experts knowing how to use a designer component of the preferred decision system, rely on the users and/or strategy consultants for the domain expertise needed to construct optimal solutions to business problems.

On page 15, lines 14-15:

- Basic ASP mode, **in which the client sends data to a data center** and receives back decisions in real time, or

On page 19, lines 5-24:

In the preferred embodiment of the invention, the code generator server 104 generates a Web page 107 that is loaded onto the Web server 111 for facilitating communication in ASP mode between the client system 11 and the decision server 109. **The Web page 107 serves as an external interface to the decision engine.** It is the address to which the input data is sent. Once it receives the input data, it calls the parser/builder 106 to convert the XML format data into a format that can be processed by the decision engine. **Once the data has been processed, the Web page returns the results via XML to the client.**

Regarding Claim 1, the Examiner's asserted that Courts teach a method comprising when said business end user is satisfied with said ... passing control to a code generator server at said host where said code generator server generates strategy service software code corresponding to said completed project for use in production in said ASP environment, and cites Courts: col. 2:62-67; see Independent Software Vendor ISV space 28 FIG. ! & associated text.

Applicant respectfully points out that what is disclosed in such passage and figure is the Courts system, which is resident at the site of the business system and not hosted at a host site as per the claimed invention, interfacing to independent software vendor (ISV)

space that may include various ISV applications, such as ECOMM or configuration applications (such as the configuration product available from CALICO).

Courts is not teaching the claimed invention. Courts' disclosure is directed to an solution resident at the enterprise itself, which completely teaches away from the heart of the claimed invention, which is that a business end user leverages services at a hosted data center.

The Examiner's attention is directed to MPEP 707.07(g) Piecemeal Examination - 700 Examination of Applications, 707.07(g) Piecemeal Examination (emphasis added):

> **Piecemeal examination should be avoided as much as possible.** The examiner ordinarily should reject each claim on all valid grounds available, avoiding, how ever, undue multiplication of references. (See MPEP § 904.03.) Major technical rejections on grounds such as lack of proper disclosure, lack of enablement, serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.
>
> **In cases where there exists a sound rejection on the basis of prior art which discloses the "heart" of the invention (as distinguished from prior art which merely meets the terms of the claims)**, secondary rejections on minor technical grounds should ordinarily not be made. Certain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition.

Applicant is of the opinion that the Examiner is applying piecemeal examination and is merely trying to meet the terms of the claims. Applicant is of the opinion that the rejection is basely because the Courts reference, as well as the other cited references, does not disclose the "heart" of the invention.

Nevertheless, Applicant has amended the independent Claims to further clarify the invention in view of the discussion hereinabove. No new matter has been added.

Further, the Examiner's attention is directed to 2143 Basic Requirements of a *Prima Facie* Case of Obviousness, Prima Facie:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In view of the discussion hereinabove and of the amendment to the Claims, Applicant asserts that the Courts reference in view of the Harrison reference does not teach all or fairly suggest, alone or in combination, the claim limitations of Claim 1. None of the other cited references add anything as well. Hence, on this basis alone, a prima facie case of obviousness has not been established.

As such, Applicant is of the opinion that the amended independent Claims 1, 9, 17, 34, and 57, and their respective dependent Claims, are in condition for allowance. Independent Claims 18 and 26 are similarly amended and are also deemed in condition for allowance. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection under 35 USC 103(a).

(b) Claims 3 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Courts and Harrison as applied to Claims 1 and 9 hereinabove, and further in view of Dodrill *et al* (Dodrill), U.S. 6,490,564.

Applicant respectfully traverses.

The rejection of Claims 3 and 11 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 1, above. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

(c) Claims 6-7 and 14-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Courts and Harrison as applied to Claims 1 and 9 hereinabove, and further in view of Humpleman *et al* (Humpleman), U.S. 6,466,971.

Applicant respectfully traverses.

The rejection of Claims 6-7 and 14-15 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 1, above. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

(d) Claims 18-19, 23-27, 31-33, 39, and 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Courts and Harrison as applied to Claims 1 and 9 hereinabove, and further in view of Marullo *et al* (Marullo), U.S. 6,157,940.

Applicant respectfully traverses.

The rejection of Claims 18-19, 23-27, 31-33, 39, and 62 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 1, above. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

(e) Claims 20 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over CHM as applied to Claims 18 hereinabove, and further in view of Ballantyne *et al* (Ballantyne), U.S. 6,687,873.

Applicant respectfully traverses.

The rejection of Claims 20 and 28 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 1, above. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

(f) Claims 21, 29, 50, and 73 stand rejected under 35 U.S.C. §103(a) as being unpatentable over CHM as applied to Claims 18 hereinabove, and further in view of Kendall *et al* (Kendall), U.S. 2002/0138449.

Applicant respectfully traverses.

The rejection of Claims 21, 29, 50, and 73 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 1, above. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

(g) Claims 22 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over CHM as applied to Claims 18 hereinabove, and further in view of Bertrand *et al* (Bertrand), U.S. 6,018,732.

Applicant respectfully traverses.

The rejection of Claims 22 and 30 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 1, above. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

(h) Claims 51, 53-56, 74, 76-79 stand rejected under 35 U.S.C. §103(a) as being unpatentable over CHM and Kendall as applied to Claims 50 hereinabove, and further in view of Humpleman.

Applicant respectfully traverses.

The rejection of Claims 51, 53-56, 74, 76-79 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 1, above. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

3. It should be appreciated that Applicant has elected to amend the Claims solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals, 65 Fed. Reg. 54603 (9/8/00). In making such amendment, Applicant has not and does not in any way narrow the scope of protection to which Applicant considers the invention herein to be entitled. Rather, Applicant reserves Applicant's right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

4. Applicant notes in passing the long pendency of this application and the many references asserted by the Examiner and overcome during the course of prosecution. Applicant has not made substantive changes to the claims with this submission. Accordingly, Applicant requests that the Examiner conclude prosecution at this point and issue a Notice of Allowance such that the application may pass to issuance as U.S. Letters Patent. Applicant is of the opinion that the Examiner has done a thoughtful and thorough examination and that Applicant has demonstrated that Applicant is entitled to a patent for this invention.

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CONCLUSION

Based on the foregoing, Applicant considers the claimed invention to be distinguished from the art of record. Accordingly, Applicant earnestly solicits the Examiner's withdrawal of the rejections raised in the above referenced Office Action, such that a Notice of Allowance is forwarded to Applicant, and the present application is therefore allowed to issue as a United States Patent. The Examiner is invited to call (650) 474-8400 to discuss the response.

Respectfully Submitted,

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